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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,091	11/16/2001	Mark Ireton	7916-005	9462
20306	7590	06/14/2005	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			LE, UYEN T	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/992,091	IRETON, MARK	
	Examiner	Art Unit	
	Uyen T. Le	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 March 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 8-15 is/are allowed.
- 6) Claim(s) 1-7 and 16-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's arguments regarding the support for claims 8-15 are persuasive. Consequently, rejection of claims 8-15 under 35 U.S.C. 112, first paragraph is withdrawn.

2. Applicant's explanations and amendment regarding claims 8-15 are acknowledged. Consequently, rejection of claims 8-18 under 35 U.S.C. 112, second paragraph is withdrawn.

3. Regarding claim 16, applicant alleges that the "list of content files" refers to identifiers of the content files and not to a collection of the files themselves. In response, applicant seems to argue limitations not reflected in the claim language. Claim 16 does not require any identifier. Therefore, rejection of claims 16-18 under 35 U.S.C. 112, second paragraph is maintained.

4. Claim 22 has been returned to its original format. Therefore, rejection to claim 22 under 35 U.S.C. 112, second paragraph is withdrawn.

5. Applicant's arguments regarding Rose and Lamkin references of record have been fully considered but they are not persuasive.

Regarding claims 1-7, applicant argues that Rose does not teach pre-selection of content to download on the media player. In response, this limitation is not reflected in the claim language. Claim 1 merely requires "a content database for storing the at least one organizational task to be executed upon connection of the media player to a content source". The claimed organizational task is broad enough to read on the task of check in, check out of the multimedia asset management program 22 stored at the client 16 in the system of Rose (see Figure 1, column 1, line 63- column 2, line 34).

Applicant further argues that Rose does not teach a database for storing task that is separate from the content source. In response, this limitation is not reflected in the claim language. Furthermore, Rose clearly shows a database for storing software, data used by the client and copies of selected multimedia from the server that is separate from the server which is the content source (see column 3, lines 29-49).

Applicant argues that as a result of the claim language in claim 1, content is pre-selected for download for example. In response, claims are entitled to their broadest reasonable interpretation. Claim 1 broadly interpreted does not require pre-selection nor downloading pre-selected content.

Regarding claims 19-21, 23, 24, applicant seems to argue the order of the operations claimed. However, claim 19 does not specifically recite any order. Again, claims are entitled to their broadest reasonable interpretation. Thus claim 19 is broad enough to read on the teachings of Lamkin.

Applicant presents no further arguments. For all the reasons stated above, rejection of claims 1-7, 19-22 is maintained using the references of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood how the selection of content files after being added to the database within the player does not exist on the player as recited in claim 16.

Art rejection is applied to claims 16-18 as best understood in light of the rejection under 35 U.S.C. 112, second paragraph discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose et al (US 5,752,244) of record.

Regarding claim 1, Rose discloses the claimed media player including a storage to store content files (see the abstract), a user interface allowing a user to make content selections (see Figure 5), a content database to manage relationships between content selections and the content files (see item 21 in Figure 4), a processor to perform at least one organization task on at least one of the content files based upon the content

selection (see column 25, lines 6-47). The claimed content database merely stores at least one organizational task to be executed upon connection of the player to a content source. The media player of Rose clearly includes such a database since it executes an organization task upon connection of the player to a content source (see check-in, column 1, line 62- column 2, line 5).

Regarding claims 2, 3, Rose discloses that the content files are music files and video files (see the abstract).

Regarding claim 4, Rose discloses a user interface including a display and control buttons (see Figure 5).

Regarding claim 5, Rose discloses a user interface comprising a display and alphanumeric keypad when Rose shows that the client computer is a personal computer with Window operating system (see column 25, lines 26-32).

Regarding claim 6, Rose discloses sorting the content files when Rose shows that the projects are indexed in the project table 80 (see column 7, lines 1-3).

Regarding claim 7, Rose discloses searching the content files (see Browser/Search in Figure 4).

8. Claims 16-21, 23, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamkin et al (US 20040220926) of record.

Regarding claim 19, Lamkin discloses all the claimed subject matter (see Figure 17, 0027-0028, 0121, 0462), including "receive a user input...content files" (0027), "add the selection of content files to a list of content files on a database within the machine"

(a collection is created in Lamkin, thus the content files requested have to be added to a list of content files on a database within the machine), “connect the machine” (player) “to a source of content” (offsite content source 2106) and “execute predefined rules to perform at least one operation on content files associated with the selection of content files after connection to the source of content” (download only entities that meet a set of criteria).

Regarding claim 20, Lamkin discloses wherein the code when executed causes the machine to add content files to the media player (downloading, 0027).

Regarding claim 21, Lamkin discloses wherein the code when executed causes the machine to delete at least one content file on the media player (0037).

Regarding claim 23, Lamkin discloses wherein the code when executed causes the machine to transfer content to fill play lists (downloading 0027).

Regarding claim 24, Lamkin discloses wherein the code when executed causes the machine to transfer content across play lists (0271).

Claims 16, 17, 18 substantially recite the limitations of claims 19, 23, 24 in form of method, thus are rejected for the same reasons stated in claims 19, 23, 24 above.

9. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Lamkin et al (US 20040220926) of record, further in view of Rose et al (US 5,752,244) of record.

Claim 22 merely reads on the fact that content file is returned to content source and a deleted content file can no longer be transferred to the content source. Although Lamkin does not specifically show these features, Rose shows that it is well known in

the art to check-in content file (see column 1, line 63- column 2, line 34). Therefore, it would have been obvious to one of ordinary skill in the art to include the claimed features in order to return unwanted content files and save memory.

Allowable Subject Matter

10. Claims 8-15 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not disclose or make obvious selecting content files by accessing a database within the media player, the database provides a list of content files that do not exist on the media player, connecting the media player to a source of content for performing at least one operation on the content files, including all the limitations of claim 8.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chasen et al (US 6,760,721) teach a system and method for managing metadata.

Kaplan et al (US 2002/0180803) teach managing multimedia content.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13 June 2005



UYEN LE
PRIMARY EXAMINER